

Remarks

Summary of the Office Action

Claims 1-177 are pending in the application.

The Examiner objects to the declaration as being defective for not having been signed by all of the inventors.

Claims 1-12, 15-47, 49-71, 74-106, 108-130, 133-165, and 167-177 are rejected under 35 U.S.C. § 102(e) as being anticipated by Israel et al U.S. Patent 6,766,307 (hereinafter "Israel").

Claims 13, 14, 72, 73, 131, 132 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Murray et al. U.S. Patent 5,023,851 (hereinafter "Murray").

Claims 47, 48, 106, 107, 165, and 166 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Sloo U.S. Patent 5,895,450 (hereinafter "Sloo").

Claims 53, 112, and 117 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Israel in view of Eaglesham et al. Financial Times, October 16, 2000, page 25, "Online arbitration business law."

Summary Applicants' Reply

Applicants have amended claims 1, 29, 45, 49, 50, 60, 88, 104, 108, 109, 119, 147, 163, 167 and 168 to more particularly define the invention. Applicants have also cancelled claims 3, 31, 52, 62, 90, 111, 121, 149, and 170, without prejudice. No new matter has been added and the amendments are fully supported and justified by the specification.

Reconsideration of this application in light of the following remarks is hereby respectfully requested.

Applicants' Reply to the Examiner's  
Objection to the Declaration

The Examiner objects to the declaration as being defective for not having been signed by all of the inventors.

Declaration and Power of Attorney documents signed by inventors Richard D. Bailey, Daniel R. Vasileniuc, and Morton Mease were previously submitted on November 21, 2001 with the filing of this application. Copies of these Declaration and Power of Attorney documents are enclosed herewith.

Supplemental Declaration and Power of Attorney documents signed by inventors William K. Slate, II, John C. Emmert, Jr., Richard W. Naimark, Francesco Rossi, Debi Miller Moore, Gerald Strathmann, Cynthia Rumney, Joseph Williams, Interna Khutorsky, Oggy Doytchinov, Douglas W. Chriman, Robert S. Zylowski, Charles B. Kreitzberg, and Jodie Green were previously submitted on June 2, 2002 in response to a Notice to File Missing Parts. Copies of these supplemental Declaration and Power of Attorney documents are enclosed herewith.

Applicants respectfully submit that the Declaration and Power of Attorney documents and the supplemental Declaration and Power of Attorney documents contain the signatures of all of the inventors.

Applicants note that the June 2, 2002 Supplemental Declaration and Power of Attorney documents contain a clerical error in the Application No. of the application. In particular, in these the Application No. is listed as "06/990,402" instead of "09/990,402." The

remaining information identifying the application, including the names of the inventors, the attorney docket number, the title, and the filing date, is all correct.

Applicants respectfully submit that in spite of this clerical error these supplemental Declaration and Power of Attorney documents still comply with the minimum identification requirement of 37 C.F.R. § 1.63 (see MPEP 602-IV\*).

Accordingly, applicants respectfully submit that the supplemental Declaration and Power of Attorney documents are valid and thus the declaration has been signed by all of the inventors. As such, the Examiner's objection to the declaration should be withdrawn.

Applicants' Reply to the Rejection of  
Claims 1, 60, and 119 Under 35 U.S.C. § 102(e)

Claims 1, 60, and 119 are rejected under 35 U.S.C. § 102(e) as being anticipated by Israel.

Applicants' claimed approach for managing the resolution of disputes and that of Israel are fundamentally different. Applicants' approach allows a case manager to "manage the dispute management process" using a computer. As part of managing the dispute, the case manager "guid[es] the user and the ... party" with whom the user has a dispute "through a dispute resolution process."\*\* (See Applicants' specification, p. 35.) In addition, the case

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\* "[C]ompliance with any one of the following items below will be accepted as complying with the identification requirement of 37 CFR 1.63: . . . (C) attorney docket number which was on the specification as filed"

\*\* These claims have also been amended to clarify that the neutral facilitates the dispute resolution process.

manager selects a neutral that will facilitate the dispute resolution process via a third computer. (See Applicants' specification, p. 37.)

Israel does not use a case manager, but is rather more like a "do-it-yourself" system. The entities who access the Israel system, other than those involved in the dispute (called "program users"), are called "program manager" and "administrative personnel." (Israel, column 3, lines 11-13, 36-37). Neither of these is the case manager claimed by applicants, because neither "guid[es]" parties "through the dispute resolution process" or selects a neutral.

In contrast to the case manager of applicants' claims, Israel's "program managers are individuals at a company . . . responsible for maintaining the account with the present system [and] program users are individuals within those companies . . . who have the authority to settle disputes" (Id., column 11, lines 42-49). As representatives of a single party in a dispute, it is plain why Israel's program manager (or a program user for that matter) does not manage the dispute resolution process and guide the other adverse party through the dispute resolution process. For the same reason, the program manager does not select the neutral that facilitates the dispute resolution process.

Further, Israel's administrative personnel are plainly not the claimed case manager. The administrative personnel are akin to technical support. They "ensure that the system is functioning properly" and "ensure[] that disputes are settled properly from a technical perspective" (Id., column 21, lines 19-20 and 54-55). They do not guide

the user and the other party through the dispute resolution process and do not select neutral parties.

In conclusion, none of the users of Israel's system guide both parties through the dispute resolution process and select the neutral parties that facilitate the dispute resolution process as claimed by Applicants.

Accordingly, because Israel fails to show each feature of applicants' amended independent claims 1, 60, and 119 the rejection over Israel under 35 U.S.C. § 102(e) should be withdrawn.

Applicants' Reply to the Rejection of  
Claims 29, 88, and 147 Under 35 U.S.C. § 102(e)

Claims 29, 88, and 147 are rejected under 35 U.S.C. § 102(e) as being anticipated by Israel.

Applicants' method and systems of independent claims 29, 88, and 147, are directed towards, generally speaking, providing dispute management features in a dispute management application that includes providing a case filing application for allowing users to file a claim. Applicants have amended claims 29, 88 and 147 to include the assignment of a "case manager" that "guid[es] the user and an adverse party to the user's claim through the dispute resolution process."

As stated above with respect to applicants' amended independent claims 1, 60, and 119, Israel does not disclose the claimed case manager. Accordingly, because Israel fails to show or suggest every limitation of applicants' amended independent claims 29, 88, and 147 the rejection over Israel under 35 U.S.C. § 102(e) should be withdrawn.

Applicants' Reply to the Rejection of  
Claims 45, 104, and 163 Under 35 U.S.C. § 102(e)

Claims 45, 104 and 163 are rejected under 35 U.S.C. § 102(e) as being anticipated by Israel.

Applicants' amended independent claims 45, 104 and 163 (and their dependent claims) are, generally speaking, directed towards approaches for preventing disputes between parties by monitoring communications between the parties and determining, from those communications and other information stored in a database, whether a dispute may arise. A user of the system is notified of the potential dispute so that the user may potentially avoid the dispute and preserve the business relationship with the other party. Embodiments of these approaches are described, for example, in Applicants' specification at pp. 53-54.

As set forth in the claims, communications from a first computer are monitored. These communications "reflect commercial activities between a user and another party." (See Applicant's specification, p. 53). Information from the communications is compared "with dispute management criteria from a database." Based at least in part on this comparison, dispute prevention information is determined. For example, it may be determined that "9 out of 10 times a dispute arises" when commercial activities such as those reflected in the communications occur. (See Applicant's specification, p. 54). The dispute prevention information is provided to the user "to notify the user of a potential dispute."

Applicants' respectfully submit that Israel does not disclose anything like the drained systems and method

(or their dependent claims). Accordingly, the rejection over Israel under 35 U.S.C. § 102(e) should be withdrawn.

Applicants' Reply to the Rejection of  
Claims 50, 109, and 168 Under 35 U.S.C. § 102(e)

Claims 50, 109, and 168 are rejected under 35 U.S.C. § 102(e) as being anticipated by Israel.

Applicants' method and systems of claims 50, 109 and 168 (and their dependent claims) are directed toward providing features for managing disputes or potential disputes between entities in different countries. As set forth in the claims, communications between two users are "monitor[ed] to "identif[y] the country that the second user is communicating from." Based on that identification, the other user (the "first user") is provided with dispute management information appropriate for that country. For example, this information may include alternative dispute resolution clauses that are appropriate under a particular country's law. (See, e.g., applicants' specification, p. 56). This part of the claimed method and systems may be used, for example, before a dispute arises to assist parties or dispute management personnel in specifying how future disputes are to be resolved.

A second part of the claimed method and systems involves providing dispute management features based on the identification of the country. Dispute management rules (e.g., arbitration rules) appropriate to the country are determined. Dispute management features appropriate to that country of the second user are then provided.

Applicants' respectfully submit that Israel does not disclose anything like the method and systems of these claims (or their dependent claims). Accordingly, the

rejection over Israel under 35 U.S.C. § 102(e) should be withdrawn.

Applicants' Reply to the Rejection of Claims  
2-28, 30-44, 46-49, 51-59, 61-87, 89-103, 105-108,  
110-118, 120-146, 148-162, 164-167, and 169-177

The remaining dependent claims all depend from claims that are novel and non-obvious over the prior art. Accordingly, for at least this reason (and applicants reserve the right to argue additional reasons should prosecution continue), the rejection of these claims should be withdrawn (In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Request for Signed Form PTO-1449

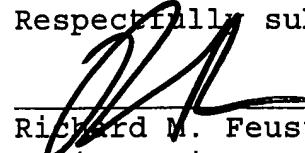
Applicants have not yet received signed copies of Forms PTO-1449 from the Information Disclosure Statements filed on January 28, 2002, May 27, 2003, and September 24, 2004. Applicants request that a signed copy of the Forms PTO-1449 be returned with the next Office Action.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in

condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,

  
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